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### **REMARKS**

In this non-final Office Action, claims 1-16 are pending, of which claims 1-16 stand rejected. By this response, claims 1, 4, and 7-8 are amended, and claims 2-3, 5-6, and 9-16 continue unamended. Arguments addressing the Examiner's position are provided. In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are anticipated or obvious under the provisions of 35 U.S.C. §102 and 35 U.S.C. §103. Thus, the Applicants believe that all of these claims are now in allowable form.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

### **CLAIM OBJECTIONS**

The Examiner has objected to claim 4 because of lack of antecedent basis for the term "cable distribution." Applicants respectfully traverse the Examiner's objection.

In response to the Examiner's objection to claim 4 because of lack of antecedent basis for the term "cable distribution," Applicants have amended claim 4 to change the term "cable distribution" to --cable distribution network--. In view of such amendment, Applicants submit that the Examiner's objection is moot and should be withdrawn.

### **REJECTION OF CLAIMS UNDER 35 U.S.C. §102**

#### **Claims 1-4 and 6-8**

The Examiner has rejected claims 1-4 and 6-8 as being anticipated by Rao (U.S. Patent 5,940,738, hereinafter "Rao"). The Applicants respectfully traverse the rejection.

The Applicants' independent claim 1 recites:

"A method for delivering short-time duration video segments in a multiplexed transport stream to terminals via a communications network, the method comprising:

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receiving from a terminal a request for a video segment corresponding to a selected object;  
processing the request at a session manager; and  
transmitting a control message from the session manager to a transport stream generator, said control message indicating whether one of the oldest transport streams of said multiplexed transport stream may be discontinued by said transport stream generator to release bandwidth, said transport stream generator maintaining status of streams being served, and transmitting said video segment if sufficient bandwidth is available, said transmitted video segment adapted for presentation at said requesting terminal and including a beginning portion of said video segment." (emphasis added)

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). The Rao reference fails to disclose each and every element of the claimed invention, as arranged in the claim.

The Rao reference discloses"

"For a network as in FIG. 12B where the OD-NVOD is in direct communication with the settop units, request processor 1110 maintains for each channel a list of settop units that have requested the program transmitted over that channel. When a settop unit ceases to monitor a program (or is powered off), it sends a cancellation request to the OD-NVOD server. The OD-NVOD server responds to the cancellation request by deleting that settop unit from the list of requesters. Once the list of requesters for a particular channel is empty, the OD-NVOD server ceases transmission on that channel. The OD-NVOD server may check if the list is empty either periodically or whenever a cancellation request is received." (See Rao, column 20, lines 30-42.)

By contrast, the Applicants' invention provides:

"In one embodiment, the TSG 604 maintains a status for each variable demand-cast stream being served. The status is adjusted upon receipt by the TSG 604 of certain messages from the SM 602. The basic states for the status comprise an "acquired" state which denotes that the demand-cast stream is in use by one or more terminals 606, and a "released" state which denotes that that the demand-cast stream is not in

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use by any terminal 606. The TSG 604 keeps serving "acquired" demand-cast streams by multiplexing them into appropriate transport streams and replaces "released" demand-cast streams with new demand-cast streams upon receipt of a request message from the SM 602. In a preferred embodiment, the TSG 604 also keeps track of the order in which the streams are released, so that the oldest released stream may be used as the preferred candidate for replacement." (See Applicants' specification, page 9, lines 14-24.)

More specifically, the Rao reference discloses that the request processor 110 maintains for each channel a list of set top units that have requested the program transmitted over that channel. By contrast, the Applicants' invention provides that the transport stream generator maintains the status for each variable demand cast stream being served. Therefore, the Rao reference fails to teach each and every element of the claimed invention, "as arranged in the claim."

As such, the Applicants submit that independent claim is not anticipated and fully satisfies the requirements of 35 U.S.C. §102 and is patentable thereunder. Furthermore, claims 2-4 and 6-8 depend, either directly or indirectly, from independent claim 1 and recite additional features thereof. As such and at least for the same reasons as discussed above, the Applicants submit that these dependent claims are also not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

#### **REJECTION OF CLAIMS UNDER 35 U.S.C. §103**

##### **Claim 5**

The Examiner has rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Rao in view of Hendricks et al. (U.S. Patent No. 5,559,549, hereinafter "Hendricks"). The Applicants respectfully traverse the rejection.

The Applicants' explanation of Rao with respect to the §102 rejection is also applicable with respect to the §103 rejection herein. As such, and for brevity, that explanation will not be repeated in as great detail. As indicated, Rao does not teach or

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suggest "said transport stream generator maintaining status of streams being served." Rather, the Rao reference merely discloses that the request processor maintains for each channel a list of set top units that have requested the program transmitted over the channel.

The addition of Hendricks does not correct the deficiencies of Rao. Hendricks discloses a digital television program delivery system that provides subscribers with a menu-driven access to an expanded television program package. The system allows for a number of television signals to be transmitted by using digital compression techniques. However, Hendricks is silent with respect to the transmission of a control message by the session control manager to the transport stream generator and maintaining status of the transport stream generator, as recited in Applicants' claim 1.

For prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. §103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Nowhere in the combination of references is there any teaching, suggestion, or incentive to include "said transport stream generator maintaining status of streams being served." Therefore, the combination of Rao and Hendricks fails to teach or suggest the Applicants' invention as a whole.

As such, the Applicants submit that claim 5 (at least for its dependency upon non-obvious independent claim 1) is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103 rejection.

#### **Claims 9-14**

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The Examiner has rejected claims 9-14 under 35 U.S.C. §103(a) as being unpatentable over Rao in view of Aharoni et al. (U.S. Patent 6,014,694, hereinafter "Aharoni"). The Applicants respectfully traverse the rejection.

Applicants' explanation of Rao with respect to the §102 rejection is also applicable in this section. As such, and for brevity, those comments will not be repeated. The addition of Aharoni does not correct the deficiencies of Rao. Aharoni discloses transporting video over networks wherein the available bandwidth varies with time. Specifically,

[t]he system comprises a video/audio codec that functions to compress, code, decode and decompress video streams that are transmitted over networks having available bandwidths that vary with time and location. Depending on channel bandwidth, the system adjusts the compression ratio to accommodate a plurality of bandwidths ranging from 20 Kbps for POTS to several Mbps for switched LAN and ATM environments. See Aharoni Abstract.

Additionally, the Examiner provides alleged support in Aharoni for the various dependent features recited in claims 9-14; however, Aharoni is also silent with respect to the transmission of a control message from the session manager, as recited in Applicants' claim 1. Nowhere in the combination of references is there any teaching, suggestion, or incentive to include a control message from the session manager to the transport stream generator indicating whether a "transport stream may be discontinued by the transport stream generator to release bandwidth, and the transport stream generator maintaining status of streams being served" as recited by the Applicants.

Therefore, the combined references fail to teach the Applicants' invention as a whole. As indicated above, Rao or Aharoni do not render Applicants' claim 1 obvious. In addition Applicants' claims 9-14 depend (either directly or indirectly) from claim 1 and recite additional features therefore. As such, the Applicants submit that claims 9-14 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejection be withdrawn.

#### **Claims 15-16**

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The Applicants note that the Examiner has inadvertently forgotten to address claims 15 and 16 in the present Office Action. However, the Applicants submit that neither the Rao reference nor the Rao reference in combination with Hendricks teach or suggest the Applicants' claimed invention of "the transport stream generator maintaining status of streams being served," as recited in part in both dependent claims 15 and 16. As such, the Applicants submit that these dependent claims also are not anticipated or obvious and fully satisfy the requirements of 35 U.S.C. §102 and §103 and are patentable thereunder.

#### **SECONDARY REFERENCES**

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the Office Action. Therefore, the Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

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### CONCLUSION

Thus, the Applicants submit that all the claims presently in the application are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited. If at any point during the prosecution the Examiner believes a telephone call would assist in resolving one or more of the issues brought forth during the prosecution history, Applicants are open to discussion of these issues and requests Eamon J. Wall, Esq. be contacted at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

3/4/05

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